REMARKS

The above amendment and these remarks are responsive to the Office Action mailed 21 Jan 2004 by Examiner Rachel L. Porter.

Claims 1-19, and 22-27 are pending in the case, with allowance of claims 1-7, 10 and 11 being withdrawn, such that no claims are currently allowed.

35 U.S.C. 101

Claims 4-5, 8-9, 12-15 and 17 have been rejected under 35 U.S.C. 101 as directed to non-statutory subject matter.

Applicants have amended independent claims 4, 8, 12,

and 17 to clarify that claims 4-5, 8-9, 12-15, and 17 are within the technological arts, and urge that the rejections of these claims be withdrawn.

35 U.S.C. 112

Claims 6-7, 10-11, and 16 have been rejected under 35 U.S.C. 112, second paragraph.

Applicants have amended independent claims 6, 10, and 16, as implicitly suggested by the Examiner, to clarify that means for performing first and second prioritization processes are being claimed.

Applicants urge that the rejection of claims 6-7, 10-11, and 16 under 35 U.S.C. 112 be withdrawn.

35 U.S.C. 103

Claims 1-7, 10-17, and 22-26 have been rejected under 35 U.S.C. 103(a) over Davis et al. "The Information System Consultant's Handbook: Systems Analysis and Design", CRC Press, in view of Feurer et al. "Performance Measurement in Strategic Change."

Claims 8-9, 18-19, and 27 have been rejected under 35 U.S.C. 103(a) over Davis in view of Nagai et al., U.S. 2001/0025247 A1, and further in view of Feurer.

These claims all recite the first and second prioritization processes of applicants invention. The first prioritization exercise 328 is described beginning at page 26 of applicants' specification, as follows:

> "In step 344, a first prioritization exercise 328 is performed on the measures in the first draft 326 of measurement model 102. For each of the measures identified in step 342, <u>a table is built that describes the relationship with each of the behaviors it may satisfy.</u> In many cases, a single measure may actually satisfy more than one behavior. This is important in the identification and selection of measures, since it is most desirable <u>to keep the final number of measurers to a minimum</u>. This prioritization process is done for

each of the categories of the measurement model 102. Table 3, First Prioritization Example: People Measurements, illustrates how to capture the prioritization in this step 344."

"The measurement subtotal scores in Table 3 are derived from simple counts of the numbers of X's in each of the columns. Those <u>measures with the highest scores satisfy the most number of behaviors</u> and are more desirable as measurers in the model since they provide more knowledge and insight for the cost of implementation." (Emphasis added.)

The second prioritization exercise 330 is described beginning at page 30 of applicants' specification, as follows:

"In step 345, the second prioritization process 330 is performed on the measurements in the first draft 326 of measurement model 102. <u>For each of the measures identified in step 342, a table is built that describes the related measure. In many cases a single measure may actually be related to more than one measure. This is important in the identification and selection of measures, since it is most desirable to keep the final number of measures to a minimum</u>. This prioritization process 330 is done for each of the categories of the measurement model. Table 4, Second Prioritization Example: People Measurements, illustrates how to capture the prioritization in this step 345."

"The measurement subtotal is derived from the sum of X's in each of the columns. Those measures that have the highest scores also have the highest number of related measures, making them desirable as measurement for the base model. When prioritized against the results of the behaviors to measurement matrix (Table 3), an initial set of measurements can be identified. The cells with a "0" entry indicate the same measure to same measure condition, which should not be considered in the matrix, because it is not meaningful to relate a measure to itself."

"In step 346, the results of the prioritization processes 328 and 330 are used to build the second draft 332 of measurement model 102. The tables built in steps 344 and 345 are used to select those measures that should be included in the final measurement model. A simple approach is to calculate the mean values of measurement subtotals from each of Tables 3 and 4 and select those measures that have scores greater than or equal to that mean."

As an example, in step 344, the mean score is

$$[(2+2+2+0+4+4+4+1)/8] = 2.375$$

"As a result, the following measures would be selected: contractor engagement duration, contractor usage, and unfilled positions. Some measures may need to be included in measurement model 102 in exception of this prioritization process either because of specific customer need or because it may be the only measure

that satisfies a particular behavior and/or goal."

The effect of this process is to select a minimum or optimum set of measures which together satisfy the behaviors or goals defined for the model.

The Examiner, in discussing each of the independent claims of the case, observes that:

> "Davis... does not expressly disclose executing a first prioritization process determining for each metric relationship with each said behavior satisfied by said metric and a second prioritization process determining for each metric a relationship with other metric." (Office Action, page 8. Thereafter repeated with respect to each independent claim.)

The Examiner then relies on Feurer for this teaching, stating:

> "Feurer teaches developing models using multiple hierarchies (i.e. first and second prioritization processes) that include relating metrics to behaviors satisfied by the metrics and relating the metrics to one another. (paragraphs 17, 26-31,34-38)" (Office Action, page 8. Thereafter repeated with respect to each independent claim.)

Applicants observe that Feurer does not teach, however, a process as taught by applicants for finding a minimum set of measures that drive desired behaviors or conduct. Neither is such taught by Davis or Nagai, or their combination.

Applicants have amended the independent claims of the case to clarify this aspect of their invention.

SUMMARY AND CONCLUSION

Applicants urge that the above amendments be entered and the case passed to issue with claims 1-19 and 22-27.

The Application is believed to be in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707.02(j) and 707.03 in order that allowable claims

can be presented, thereby placing the Application in condition for allowance without further proceedings being necessary.

Sincerely,

S. M. Jordan, et al.

By

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